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PATENT
Attorney Docket No.: 020375-002910US

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By: /Nina L. McNeill/
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of:

Stephen Chin

Application No.: 10/045,313

Filed: October 24, 2001

For: INTERNET-BASED MONETARY
PAYMENT SYSTEM

Confirmation No. 3142

Examiner: Dass, Harish T.

Art Unit: 3628

APPELLANT REPLY BRIEF UNDER 37
CFR §41.41

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellant offers this Reply Brief in response to the Examiner's Answer mailed on April 7, 2006. The following remarks are intended to further focus the issues in this appeal.

1. Claims 11 – 14

The portion of the Answer captioned "Response to Arguments" again cites a number of portions of Jennings that the Answer implies are relevant to the limitation of independent Claim 11 requiring that "the request [to transfer at least some of the funds in the stored value account to a recipient be] received in response to and substantially contemporaneous with consummation of a transaction between the sender and recipient." But the Answer continues to omit any specific identification of what portion of Jennings discloses the

“transaction” recited in the claims, leaving the Board and Appellants to attempt to infer the precise basis for rejection.

As Appellants best understand by the Answer’s repeated focus on the characterization of the funds transfer in Jennings as occurring “instantly” or “in real time” (Answer, pp. 8 – 10), the Answer views the funds transfer itself in Jennings as the “transaction” recited in the claims. Such a view is entirely inconsistent with the claim requirement that the request to transfer funds be “received in response to ... consummation of [the] transaction” (emphasis added). It is logically axiomatic that a request that initiates the funds transfer cannot be received in response to its own consummation.

Since the Answer still fails to identify any transaction between the sender and recipient in Jennings separate from the funds transfer so that the “request [is] received in response to and substantially contemporaneous with consummation of [the] transaction,” at least one of the claim elements has not been identified in the prior art. Accordingly, no *prima facie* case under §103(a) has been established. Claims 11 – 14 are therefore believed to be patentable.

2. Claims 15 – 21

The Answer appears to provide a twofold response to the arguments made in the Appeal Brief regarding independent Claim 15. First, the Answer seems to suggest that the “payment instrument” recited in the claim may read on a “personal computer” or some software architecture that handles such functions as external transfers, standing orders and direct debits (*id.*, p. 11; the “application 84” identified in l. 2 of p. 11 is part of the software architecture shown in Fig. 5 of Jennings (*see* Jennings, Col. 8, ll. 3 – 16)). Second, the Answer argues that the claim limitations related to the payment instrument in Claim 15 are disclosed by certain functionality of the ATM in Jennings to perform “cash withdrawal, deposits and payments, transfer between accounts, balance inquiries, transaction histories, and purchases of travelers checks” (Answer, pp. 11 and 12, particularly p. 11, ll. 15 – 17 and p. 12, ll. 6 – 9 citing Jennings, Col. 6, ll. 15 – 18).

With respect to the first part of this response, Appellants acknowledge that devoid of any other context, the word “instrument” could refer to a device like a personal computer or to software architecture. But context is provided by how the word is used in the claims. Independent Claim 15 specifically refers to a “payment instrument” that is subject to “an authorization request to charge the payment instrument” and to “an authorization to charge the payment instrument.” As such, the payment instrument is a form of financial instrument against which charges may be made, such as the credit card recited explicitly in Claim 21. Neither a personal computer nor software architecture is such an instrument.

With respect to the second part of the response, it is respectfully noted that the ATM functionality highlighted by the Answer is irrelevant to those claim limitations involving the payment instrument. The ability of the ATM in Jennings to enable the identified functionality (withdrawals, deposits, account transfers, balance inquiries, transaction histories, and purchases of travelers checks) is unrelated to use of a payment instrument to support a funds transfer over the Internet by those steps specifically recited in the claims. Indeed, the Answer now additionally asserts that certain functionality is “well known” (Answer, p. 11, l. 18 – p. 12, l. 2 and p. 12, ll. 15 – 19). In addition to this functionality also being irrelevant to use of a payment instrument as recited in the claims, such assertions are made without relying on Official Notice and without providing any documentary evidence to demonstrate that this functionality is prior art to the application. It is thus respectfully believed that the additional remarks made in the Answer still fail to demonstrate that those claim limitations related to a payment instrument are disclosed in the prior art.

Without such a demonstration, no *prima facie* case has been established under §103(a) and Claims 15 – 21 are accordingly believed to be patentable.

Respectfully submitted,

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